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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,041	10/17/2001	Wolfgang Ruf	P21325	3688

7055 7590 07/02/2002

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EXAMINER

HASTINGS, KAREN M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 07/02/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/978041

Applicant(s)

Ruf et al

Examiner

HASTINGS

Group Art Unit

1731

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

☒ Responsive to communication(s) filed on 1-02

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-50 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-50 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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*Claims 1-50 are rejected under 35 U.S.C. § 112, second paragraph*, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The terms "high performance", "high" and "good to very good" in claims 1 and 26 are relative terms which render the claim indefinite. The terms "high performance", "high" and "good to very good" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The terms "high performance", "high stability", "high heat resistance", and "good to very good resistance . . ." are all relative terms. They are comparative terms, without setting forth a standard of comparison in the claims. Therefore one would not know the metes and bounds of these claims.

It appears that the properties set forth in the dependent claims define what is meant by some of these terms, and this is more confusing as to what independent claims 1 and 26 actually define since applicants set forth the values of the properties that appear to be what applicants intend to define these terms.

In any event, it is suggested that in order to be definite claims 1 and 26 must be amended to clearly provide what the

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properties of the high performance polymer are in order to properly set out the metes and bounds of the claims.

*The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102* that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

*The following is a quotation of 35 U.S.C. § 103(a)* which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly

owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

*Claims 1-50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rodal et al. or under 35 U.S.C. § 103 as unpatentable over Rodal et al. as necessary with applicants' admission of prior art (AAPA).*

Rodal et al. discloses a lamella/head box trailing element which may be made from polysulfone (PUS). See column 4 line 66 to column 5 line 6. (Note "polyuphone" at column 5 line 4 is a clear misspelling of polysulphone; this is also made clear since it is correctly spelled in claim 12 column 8 line 11).

Note this reference clearly anticipates many/most of the claims, since applicants disclose that polysulfone is an appropriate "high performance polymer" that has the appropriate property requirements. (That is, it appears to be inherent that since applicants teach that polysulfone is an appropriate high performance polymer, then polysulfone must inherently have the recited properties as recited in the dependent claims.)

Alternately, it clearly would have been *prima facie* obvious

to use PUS since Rodal et al teaches it is an appropriate material for use as a headbox lamella.

With respect to other dependent claims, they are either clearly shown or suggested by the reference, and/or would be immediately envisioned by one of ordinary skill in the art; e.g. use of the lamella/trailing element in a head box designed for any appropriate jet speed as set forth in claims 22 and 23 or in a multilayer head box as set forth in claim 24 or for a paper machine as set forth in claim 25 - all would be immediately envisioned to one of ordinary skill in the art upon reading the Rodal et al. reference.

As necessary with respect to claims for example that detail the lamella structure with a dull end and grooves etc., applicants admit on page 14 of the specification when they reference Patent 5,639,352 etc. that such head box lamella structure is known. Likewise with respect to claims reciting a head box with dilution control, AAPA admits on page 12 paragraph 64 that such multilayered head box with density control is well known in the art and as such, to use a lamella of any appropriate material such as the polysulfone recited in Rodal et al. would have been *prima facie* obvious to one of ordinary skill in the art.

With respect to claims 20 and 46, note column 5 lines 48-49 of Rodal et al. which teaches that the trailing element may be

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formed of a single material. It is of course also very well known to form the trailing element of a single material and since Rodal et al. lists polysulfone as an appropriate plastic to use for a head box trailing element, it clearly would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have used any appropriate "high performance polymer" that is, any thermoplastic that has the appropriate properties. As evidenced by Rodal et al.'s teachings, polysulfone is such a plastic for use as a head box lamella.

***Claims 15-17 and 41-43 are also rejected under 35***

***U.S.C. 103(a)*** as being unpatentable over the references as applied to the claims above, and further in view of Ewald et al. which if even necessary exemplifies that it is known that the tip end of a head box lamella may be between .2 and .5 millimeters. Thus to have used such a dimension for the trailing element of Rodal et al. would have been well within the ordinary level of skill in the art as a conventional dimension for a lamella tip thickness.

***The prior art made of record*** and not relied upon is considered pertinent to applicant's disclosure.

Sanford exemplifies grooved head box lamella structures.

***Any inquiry concerning this communication*** or earlier communications from the examiner should be directed to Examiner

Serial No. 09/978,041

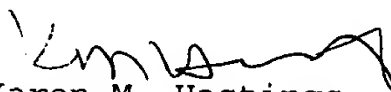
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Hastings whose telephone number is (703) 308-0470. The examiner can normally be reached on Monday through Thursday from 6:30 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Steve Griffin, can be reached on (703) 308-1164. The fax phone number for this Group is (703) 305-7115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0651.

  
Karen M. Hastings  
Senior Primary Examiner  
Art Unit 1731

KMH/cdc  
June 27, 2002

6/02